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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,059

01/16/2007

Bharat A. Mehta

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48924

7590

10/29/2009

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EXAMINER

RANADE, DIVA

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

10/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,059	<b>Applicant(s)</b> MEHTA, BHARAT A.	
	<b>Examiner</b> DIVA RANADE	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-12 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 6, 7, 9, 12, 14 and 17 are 35 U.S.C. 102(b) as being anticipated by U.S. Publication 2002/0042628 to Chin et al.

a. Claims 1 and 7: Chin shows catheter including an end portion having a platform as in claim 1 or a radially outwardly expandable ring attached to the insertion end of the catheter extending substantially radially outwardly therefrom as in claim 7 (#16) with a lumen (#14) having an insertion end and an opposite end (See Fig 4). Chin discloses that the platform is formed of a biocompatible expandable material for expanding in situ ([0038]).

b. Claim 12: Chin shows an expandable ring capable of being attached to a catheter (See Fig 4 #16).

c. Claim 3, 9 and 14: Chin shows an expandable material is capable of expanding two to three times the original size (See Fig 4).

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d. Claim 6: Chin shows that the platform is ring-shaped and is capable of being attached to a catheter (See Fig 4).

e. Claim 17: Chin discloses a method of treating an aneurysm by inserting the catheter into an artery in need of treatment (See claim 8)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5, 10-11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication 2002/0042628 to Chin et al in view of U.S Patent 5,258,042 to Mehta et al.

f. Claims 4, 5, 10, 11, 15 and 16: Chin discloses an expandable material but lacks that is hydrophilic or a hydrogel as in claim 5. Mehta discloses an expandable material that is a hydrophilic hydrogel (See Column 2 lines 54-67). It would be obvious to one skilled in the art during the time of the invention to modify the material used by Chin with the material used by Mehta in order to easily swell to full expansion.

***Response to Arguments***

5. Applicant's arguments filed 07/08/09 have been fully considered but they are not persuasive. The Abstract is not missing. However, it does not commence on a separate sheet. The submitted abstract is on a published page and does not

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begin on a separate page by itself. A separate page title Abstract with the abstract below and nothing else is required. See below:

**1.72 Title and abstract.**

<>

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. Characters that cannot be captured and recorded in the Office's automated information systems may not be reflected in the Office's records in such systems or in documents created by the Office. Unless the title is supplied in an application data sheet (§ 1.76), the title of the invention should appear as a heading on the first page of the specification.

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

[31 FR 12922, Oct. 4, 1966; 43 FR 20464, May 11, 1978; para. (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (b) revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

Furthermore, the reference still reads on the claims for the following reasons.

The reference reads on a catheter having a platform that is biocompatible and expandable since the platform is expanding in situ. The claims do not specify that the material is self expanding or that it does not require any further assistance from a surgeon etc. Therefore, the claims do not overcome the reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established

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by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the properties of the material are well known to the inventor and the structure as claimed reads on the prior art. Furthermore, motivation for using this material to occlude the aneurism is that the invention of patent 5,258,042 used the material to occlude the aneurism and therefore the references would be obvious to combine.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIVA RANADE whose telephone number is (571)270-7456. The examiner can normally be reached on M-F, 7:30-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DIVA RANADE/  
Examiner, Art Unit 3763

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763